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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,576	11/21/2003	Bruce Edward Matter	4437-0102P	9387
2292	7590	06/01/2006	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			MORRISON, JAY A	
			ART UNIT	PAPER NUMBER
			2168	

DATE MAILED: 06/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/717,576	Applicant(s) MATTER, BRUCE EDWARD	
	Examiner Jay A. Morrison	Art Unit 2168	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/23/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-33 are pending.

Specification

2. The use of the trademark Excel has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Conant et al. ('Conant' hereinafter) (Publication Number 2002/0129056).

As per claim 1, Conant teaches

“storing and indexing a plurality of clauses” (clause database, paragraph [0046]; figure 6, item 600);

“selecting at least one clause from the plurality of clauses” (paragraph [0047]);

“creating a document including the at least one clause from the plurality of clauses” (contract proposal, paragraphs [0058] and [0065]);

“providing for the receiving of information corresponding to the at least one clause” (specific clause, paragraph [0065]);

“storing and associating any received information to the at least one clause” (track, paragraph [0065]);

“and displaying the received information to visually associate the received information with the at least one clause” (graphical representations of changes to specific clauses, paragraph [0065]).

As per claim 2, Conant teaches

“determining if the at least one clause is changed based upon the associated received information” (revised clauses, paragraph [0065]);

“and storing the change to the at least one clause based upon the determination” (paragraph [0065]).

As per claim 3, Conant teaches

“any received information is at least one of a proposed change to the at least one clause, comments related to the at least one clause, identification information of the source of the received information, a time the received information was received, and a date the received information was received” (paragraph [0065]).

As per claim 4, Conant teaches

“the plurality of clauses are indexed using predefined categories” (types of documents, paragraph [0015]).

As per claim 5, Conant teaches

“the predefined categories relate to different types of clauses included in contracts” (clause type, paragraph [0056]).

As per claim 6, Conant teaches

“the information associated to the at least one clause may be archived for future consideration” (comment history, paragraph [0067]).

As per claim 7, Conant teaches

“the received information may be provided over a network” (paragraph [0017]).

As per claim 8, Conant teaches

“the document resides on a server accessible by at least one client over a network” (paragraph [0017]).

As per claim 9, Conant teaches

“generating a final document based upon the document and the associated information” (contract proposals, paragraph [0074]).

As per claim 10, Conant teaches

“the document relates to at least one of government procurement processes, rulemaking processes, legislative processes, and peer review processes” (paragraph [0015]).

As per claim 11, Conant teaches

“storing additional information related to the document, wherein the additional information includes at least one of business rules, legal rules, and other information that may contribute to the generating of the final document” (comment history, paragraph [0065]);

“and associating the additional information with the at least one clause” (comment history specific to particular clauses, paragraph [0065]).

As per claims 12-22,

These claims are rejected on grounds corresponding to the arguments given above for rejected claims 1-11 and are similarly rejected.

As per claims 23-33,

These claims are rejected on grounds corresponding to the arguments given above for rejected claims 1-11 and are similarly rejected.

Conclusion

5. The prior art made of record, listed on form PTO-892, and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jay A. Morrison whose telephone number is (571) 272-7112. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim Vo can be reached on (571) 272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2168

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jay Morrison
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JM



Tim Vo
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